UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,717	02/12/2004	Christopher James Dawson	AUS920030842US1	5923

45371   7590   07/25/2008
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EXAMINER
ALLEN, WILLIAM J

ART UNIT	PAPER NUMBER
3625	

MAIL DATE	DELIVERY MODE
07/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/777,717	DAWSON ET AL.
	Examiner	Art Unit	
	WILLIAM J. ALLEN	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 May 2008*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Prosecution History Summary

Claims 1-41 have been canceled.

Claim 42 has been added.

Claim 42 is pending and rejected as set forth below.

Response to Arguments

Applicant's arguments with respect to claim 42 have been considered but are moot in view of the new ground(s) of rejection. Applicant's amendment necessitated the new grounds of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1.   **Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Broerman (US 20040054606) in view of Albazz (US 20020042782) in view of Tackman et al. (US 7051364) and further in view of Smith et al. (US 20020157004).**

Regarding claim 42, Broerman teaches a method for creating an electronic purchasing contract including:

the buyer logging on to an e-commerce website of the seller, wherein the e-commerce website displays a product listing for a product, the product listing comprising: a description of the product; and a price of the product (see at least: 0060-0061, 0076, Fig. 5 (#150-154), Fig. 5a (#190), Fig 8); Note: the buyer is shown the detailed information for the property;

the buyer making a selection to purchase the product (see at least: 0081, Fig. 9(#332)); Note: the buyer making an offer is analogous to selecting the property (*product*) for purchase;

responsive to the buyer making the selection, the seller generating a contract file (see at least: 0083, 0085); Note: responsive to the buyer offer, the seller generates a counter offer that is stored as a contract file on the server (also see 0065);

the seller writing contract terms to the contract file, (see at least: 0051, Fig. 9);

the seller writing personal information of the seller to the contract file (see at least:

0064); Note: seller disclosure information is analogous to seller personal information;

the buyer writing personal information of the buyer to the contract file (see at least: 0063,

Fig. 5C (Note: initials #193));

presenting the contract file to both the buyer and the seller to determine whether the

buyer and seller both agree to the contract terms (see at least: Fig. 9);

responsive to determining that the buyer and seller do not both agree to the contract

terms, modifying the contract file (see at least: 0085, 0087, Fig. 9 (#350 & 374));

storing the shopping token on a trusted third party computer (see at least: 0065); Note:

the modified electronic purchasing contract (*shopping token*) is stored on a computer on the real

estate network (*a trusted third party*).

Though teaching all of the above, Broerman does not teach where the file is an XML file or

where the contract terms include the product listing, shipping terms, and warranty terms.

Broerman effectively teaches storing a word processing file on the central server (see at least:

0065), as well as where contract terms include price, closing date, occupancy date, inspection

terms, or the like (see at least: 0051). The Examiner notes that the differences in the claimed

limitations and the teachings of Broerman, however, are merely in the type of file created/stored

and the type of terms that are found in the contract. These differences, then, fail to patentably

distinguish the claimed invention from the prior art and would have been obvious to one of

ordinary skill in the art at the time of invention. see *In re Gulack,* 703 F .2d 1381, 1385, 217

USPQ 401, 404 (Fed. Cir. 1983).

Despite the teaching in Broerman where digital signature technology may be used to sign the

agreed upon contract (see at least: 0042), Broerman fails to explicitly teach:

   responsive to determining that the buyer and seller both agree to the contract terms, the

buyer and the seller convert the contract file into a shopping token by both digitally signing the

contract file, and

   wherein contents of the shopping token cannot be copied by the buyer or the seller.

 In The same field of endeavor, Albazz teaches a system and method for automating contract

negotiations and facilitating contractual activities pursuant to the agreed upon contract (see at

least: abstract). Albazz further teaches creating a contract between a buyer and a seller in an

online transaction by means of a shopping token that contains a plurality of agreement terms (see

at least: abstract, 0016, 0085-0086). More specifically, Albazz teaches presenting terms to a

buyer and seller (see at least: 0096, Fig. 7-8) and determining whether the buyer and the seller

agree with the plurality of agreement terms (see at least: abstract lines 10-12, 0015, 0097, Fig. 7

(note "approve contract")). More specifically, Albazz teaches that *responsive to determining that*

the buyer and seller both agree to the contract terms, the buyer and the seller convert the

contract file into a shopping token by both digitally signing the contract file (see at least: 0025,

0043, 0097, Fig. 7-8). Additionally, Albazz shows where the created a contract profile

(analogous to the *contract file*) containing the agreed upon contract is "locked" utilizing the

aforementioned digital signatures (see at least: 0025 [note the final 2 lines], 0097). Once

approved by the negotiating parties and signed utilizing digital signature technology, the contract

elements are linked, sealed, and saved at the seller's e-commerce site or marketplace (see at

least: 0088, 0097). [Note: The saved and locked contract that is executable constitutes a *shopping*

token]. Albazz further teaches *wherein data in the shopping token cannot be cut and pasted from*

the shopping token by locking the contract to prevent accidental or deliberate changes to the

contract elements (i.e. *cut and pasting* [note applicant's specification, Paragraph 14]) (see at

least: 0016, 0086). It would have been obvious to one of ordinary skill in the art at the time of

invention to have modified the invention of Broerman to have included the noted features as

taught by Albazz in order to automate contract creation and accelerate the contract negotiation

cycle, thereby improving the efficiency of the contract negotiation process (see at least: Albazz,

0019).

  In addition, though Broerman and Albazz teaches all of the above, the combination does not

teach *wherein the shopping token comprises a read only contract between the buyer and seller*

and further *wherein an attempt to alter the shopping token renders the shopping token invalid.*

  Also in the field of electronic contract negotiations, Tackman teaches a system and a method

for creating and controlling electronic agreements utilizing digital signatures technology (see at

least: abstract). Tackman allows a buyer and seller to enter personal information for a contract

(see at least: Fig. 6 (note retailer/client information)) and stores the signed contract on a third

party computer as a shopping token (see at least: col. 2 lines 51-55, col. 11 lines 31-33). More

specifically, Tackman teaches where in response to determining that the buyer and seller both

agree to the contract terms, the buyer and the seller convert the contract file into a shopping

token by both digitally signing the contract file (see at least: abstract lines 7-10, col. 2 lines 37-

41,). Furthermore, Tackman teaches where *the shopping token comprises a read-only contract*

between the buyer and the seller (see at least: abstract lines 7-16, col. 8 lines 47-53, [Note:

Applicant's specification, Paragraph 0014 concerning "read-only"]). Tackman further teaches

wherein an attempt to alter the shopping token renders the shopping token invalid (see at least:

col. 2 lines 47-51, col. 8 lines 41-46).

It would have been obvious to one of ordinary skill in the art at the time of invention to have

modified the invention of Broerman in view of Albazz to have included the noted features as

taught by Tackman in order to provide secure management of the electronic forms to prevent

tampering or modifying the forms once the interested parties partially or fully execute the

electronic forms (see at least: Tackman, col. 1 lines 10-13).

Lastly, though Broerman and Albazz teaches the addition of a buyer and seller digital signature

in such a manner as to create a shopping token, the combination does not teach *wherein the*

buyer uses a first private to key to digitally sign the contract file and the seller uses a second

private key to digitally sign the contract file. Such features, however, would be recognized as

readily substitutable by one of ordinary skill in the art.. For example, Smith teaches where a

signed electronic contract comprises a stand-alone document (in XML in one embodiment) that

contains both human readable and machine readable representations of a business contract, and

further, utilizes cryptographic keys for verification of message exchanges between the trading

partners (see at least: 0019). More importantly, Smith teaches where each of at least two parties

signing an electronic contract digitally sign at least a portion of the electronic contract with a

private key of the cryptographic key pair for each of the at least two parties (see at least: abstract,

claim 10). It would have been obvious to one of ordinary still in the art to include the noted

features as taught by Smith because the claimed invention is merely a combination of old

elements that would have performed the same function separately as combined and one of

ordinary skill in the art would have recognized that the results of the combination were

predictable.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM J. ALLEN whose telephone number is (571)272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

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like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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